

REMARKS

Applicant respectfully traverses the rejection of claims 6 – 9, 12 – 13 and 29 under 35 U.S.C. 103(a) over Lam (EP 1203897) in view of Lam (EP 0971151) in further view of Smith (US 5,965,658).

Claims 6 – 9, 12 – 13 and 29 are patentably distinct over the combinations of references in the recitation of the secondary layer comprising about 5% to about 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Lam '897 does not teach carbon fibers in the secondary layer. Lam '897 also does not teach the carbon fibers are partially carbonized carbon fibers that are 65 – 90% carbonized. The rejection attempts to add to Lam '897 what is not there.

Nowhere does Lam '897 disclose or suggest that the secondary layer of the friction material comprises carbon fibers.

Nowhere does Lam '897 disclose or suggest that the secondary layer of the friction material comprises partially carbonized carbon fibers.

Nowhere does Lam '897 disclose or suggest that the secondary layer of the friction material comprises 5% to 35%, by weight, of partially carbonized carbon fibers.

Lam '897 does not teach that the partially carbonized carbon fibers are 65 – 90% carbonized.

Clearly, Lam '897 is deficient.

The rejection concludes it would be obvious to employ carbon fibers in the

secondary layers as of Lam '897 as taught by Lam '151 and that it would be obvious to employ partially carbonized fibers of Smith as substitute of the friction fibers and particles of Lam.

Applicant respectfully submits that no basis in fact or theory exists for making the numerous modifications needed to arrive at the claimed invention. The rearrangement of parts as suggested by the Examiner is not within the perview of one skilled in the art.

Applicant respectfully submits that in this case, a large subset of means may be known for solving the problem. In this case, given the infinite array of elements with which to start, one would not follow the exact route of the inventor. No showing has been made by the Examiner that one would follow the exact route taken by the inventor. If applying a means for solving a problem involves significant trial and error (testing) then a finding of obviousness is not warranted. See Ortho-McNeil v Mylan Laboratories, 520 F.3d 1358 (Fed.Cir. 2008), where the Federal Circuit Court affirmed a finding of unobviousness.

Applicant respectfully submits that one cannot rely on hindsight in reaching an obvious determination. It is essential that the decision maker forget what he or she has been taught by the claimed invention. One cannot use piecemeal reconstruction to arrive at the claimed invention.

To substitute carbon fibers of any kind for the carbon particles of Lam does not meet the "common sense" test of Teleflex let alone the Federal Circuit's "teaching, suggestion, motivation" test.

Appellant respectfully submits that the "common sense" test of KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385 (2007) and the Federal Circuit's "teaching, suggestion, motivation" test would not teach what is claimed.

Lam '151 does not teach that the secondary layer of the friction material comprises partially carbonized carbon fibers.

Lam '151 does not teach that the secondary layer of the friction material comprises 5% to 35%, by weight, of partially carbonized carbon fibers.

Lam '151 does not teach that the partially carbonized fibers are 65 – 90% carbonized.

The rejection attempts to add to Lam what is not there.

The rejection fails to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006).

The rejection does not provide any evidentiary basis to support the findings. See In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Smith does not teach carbon fibers in the secondary layer.

Smith does not teach that the secondary layer of the friction material comprises partially carbonized carbon fibers.

Smith does not teach that the secondary layer of the friction material comprises 5% to 35%, by weight, of partially carbonized carbon fibers.

No basis in fact or theory exists for picking and choosing from Lam '151 and Smith as suggested.

Applicant respectfully submit that one cannot rely on hindsight in reaching an obvious determination. It is essential that the decision maker forget what he or she has been taught by the claimed invention. One cannot use piecemeal reconstruction to arrive at the claimed invention. See Golight v. Walmart, CAFC 02-1608, 2004. Also see In re Fine, 837 F.2d 1071 5 USPQ 1596 (CAFC 1988). The rejection ignores the express limitations in the claims. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F2d 443, 448-449, 240 USPQ 416, 420 (Fed.Cir. 1986).

Accordingly, Applicant respectfully asks that the Examiner withdraw this

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rejection under 35 U.S.C. §103.

Applicant respectfully submits that claims 6 – 9, 12 – 13 and 29 are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

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